

## REMARKS

The following remarks are submitted in response to the final Office Action mailed August 3, 2006, setting a three-month shortened statutory period for response ending November 3, 2006. With this Amendment, Claim 26 has been amended. Claims 13-29 and 31-43 are currently pending. Reconsideration, examination and allowance of all pending claims are respectfully requested.

### 35 U.S.C. § 102(e) Rejections

In paragraph 3 of the Office Action, the Examiner rejected claim 43 under 35 U.S.C. § 102(e) as being anticipated by *Khosravi* (U.S. Patent No. 6,361,546). The Examiner states that *Khosravi* discloses a filter cartridge with a distal region and a proximal region comprising a first engagement member, and a retrieval device comprising a second engagement member that is shaped and configured to engage the first engagement member on the filter cartridge proximal region.

Applicants respectfully assert that the *Khosravi* reference does not disclose each and every element necessary to support the rejection of claim 43. Reference element 21 cited by the Examiner refers to the proximal end of a tubular member (12) which is used to support an expandable filter frame (14) having a number of struts (24). As can be seen in Figure 1 of *Khosravi*, the tubular member (12) appears to have a cylindrical outer surface (18), which permits an annular collar (30) coupled to the struts (24) to slide on the tubular member (12) in order to expand and contract the filter frame (14). This is evidence from col. 3, line 66 to col. 4, line 2 of *Khosravi*, which provides:

The tubular member 12 is preferably a section of ***substantially rigid cylindrical tubing*** having an outer surface 18, a lumen 20 extending between its proximal and distal ends 21,22, and a relatively short length L.

(emphasis added). Such configuration is also apparent from the retrieval steps depicted in Figures 2G and 2H, which show movement of the collar (30) along a cylindrical portion of the tubular member (14).

In contrast to *Khosravi*, claim 43 recites a distal protection system having, among other elements, a first engagement member shaped and configured to engage a retrieval device. The tubular member proximal end (21) referred to by the Examiner as a “first engagement member” does not appear to be shaped and configured to engage a retrieval device. To the contrary, the tubular member proximal end disclosed in *Khosravi* appears to be shaped and configured to permit sliding movement of the annular collar (30), not necessarily to engage the retrieval device.

Thus, since the *Khosravi* reference does not disclose or suggest each and every element recited in claim 43, Applicants submit that this claim is not anticipated.

### **35 U.S.C. § 103(a) Rejections**

In paragraph 5 of the Office Action, the Examiner rejected claims 13-29 and 31-42 under 35 U.S.C. § 103(a) as being unpatentable over *Khosravi* (U.S. Patent No. 6,361,546). The Examiner acknowledges that *Khosravi* fails to teach the presence of ridges to further prevent the cartridge moving distally beyond a capture means or an increased coefficient of friction on an outer surface region of the proximal region of the filter cartridge. The Examiner asserts, however, that it is known in the art that ridge or ridges/flanges enhance the prevention of the movement of one member sliding relatively to the other or increasing the coefficient of friction on a captured surface or capture means surface would enhance the prevention of movement of the captured member relative the capturing member. The Examiner then asserts that it would have been obvious to employ flanges/ridges into or to modify the cartridge surface or cuff surface of *Khosravi* to enhance the prevention of the cartridge moving relative to the retrieval catheter. The Examiner also acknowledges that *Khosravi* fails to teach a radiopaque band on the proximal region and/or radiopaque band proximate to the inflatable, but asserts that this is also well known in the art.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. See MPEP § 2143.01. The fact that the claimed invention may be within the capabilities of one of ordinary skill in the art is not in itself sufficient to establish *prima facie* obviousness. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Applicants assert that there is no motivation or suggestion to modify the tubular member proximal end with a ridge or an increased coefficient of friction since such modification would hamper the operation of the annular collar disclosed in *Khosravi*. As discussed previously, the proximal end of the tubular member in *Khosravi* appears to be configured to permit an annular collar to slide thereon to expand and contract several attached filter struts. The provision of a ridge or an increased coefficient of friction in this region, as suggested by the Examiner, would likely hamper or prevent the collar from automatically sliding distally along the tubular member

to expand the struts during delivery. The Examiner's statement that the provision of a ridge or an increased coefficient of friction would "enhance the prevention of movement" appears to acknowledge this result. Therefore, since the provision of a ridge or an increased coefficient of friction would diminish the ability of the struts to automatically expand to their enlarged condition by hampering movement of the annual collar along the tubular member, Applicants assert that there is no motivation or suggestion to provide a ridge or an increased coefficient of friction on the tubular member in *Khosravi*. Accordingly, Applicants assert that claims 13-29 and 31-42 are not obvious in view of the *Khosravi* reference.

In addition, Applicants further submit that it is not well known to provide ridges and an increased coefficient of friction on the outer surface of the proximal region of the filter cartridge, nor is it well known to provide radiopaque bands proximate to an inflatable cuff, as suggested by the Examiner. While adding a radiopaque band to the proximal region of the filter cartridge may modify the surface of the cartridge, the addition of such radiopaque band would not necessarily result in an increase in coefficient of friction, as suggested by the Examiner. Thus, for at least these additional reasons, Applicants submit that claims 13-29 and 31-42 are not obvious in view of *Khosravi*.

Reexamination and reconsideration of the claims of the present Application is respectfully requested. It is submitted that the claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

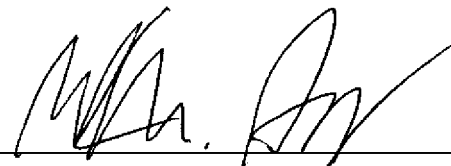
Respectfully submitted,

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By their Attorney,

Date:

Sept 13, 2005



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